

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-49, 51-57, 67, 68, 71-76 and 79-112 are presently pending in this application.

In the outstanding Office Action, Claims 1-49, 51-57, 67, 68, 71-76 and 79-112 were rejected as being based upon a defective reissue Oath/Declaration under 35 U.S.C. 251; and the amendment filed September 19, 2007 was objected to for not complying with 37 C.F.R. 1.173(b)(2).

First, Applicants acknowledge with appreciation the telephone interviews granted to Applicants' representative. Pursuant to the discussions held during those telephone interviews, Applicants respectfully submit that the amendment filed September 19, 2007 fully complies with 37 C.F.R. 1.173(b)(2) and do not contradict in a manner stated in the Office Action. Specifically, the amendments submitted on September 19, 2007 incorporate all the changes made through the amendments and certificate of correction previously made, and those changes are believed to be correctly marked-up in accordance with the current rules.

Further, in response to the objection to the reissue Oath/Declaration, Applicants respectfully submit that the reissue declaration filed July 26, 2004 fully complies with 35 C.F.R. 1.175. As seen from the attached section 1414 of MPEP, Rev. 2, May 2004 (Appendix 1), in order to satisfy the requirement (A), *i.e.*, "a statement that the applicant believes the original patent to be wholly or partly inoperative or invalid," a declaration can simply state:

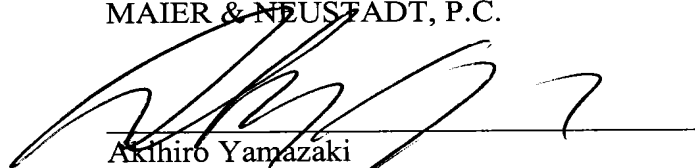
"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent."

It is believed that the foregoing statement had been sufficient and acceptable by PTO at least until the change shown in MPEP, Rev. 3, August 2005 (Appendix 2). Therefore, at the time of its filing, the subject reissue Oath/Declaration (a copy is attached herewith for your reference - Appendix 3) was believed to be fully in compliance with the requirements of 35 C.F.R. 1.175, and Applicants respectfully request that the rejection under 35 U.S.C. 251 be withdrawn.

In light of the discussions held during the telephone interviews and in view of the comments presented above, Applicants respectfully request that the foregoing outstanding objections be withdrawn, and as no further issues are believed to be outstanding, the present application is believed to be in condition for allowance. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work in a joint effort to resolve any remaining issues and expedite the prosecution of this application. Applicants respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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22850

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(b)(1) For any error corrected, which is not covered by the oath or declaration submitted under paragraph (a) of this section, applicant must submit a supplemental oath or declaration stating that every such error arose without any deceptive intention on the part of the applicant. Any supplemental oath or declaration required by this paragraph must be submitted before allowance and may be submitted:

- (i) With any amendment prior to allowance; or
- (ii) In order to overcome a rejection under 35 U.S.C. 251 made by the examiner where it is indicated that the submission of a supplemental oath or declaration as required by this paragraph will overcome the rejection.

(2) For any error sought to be corrected after allowance, a supplemental oath or declaration must accompany the requested correction stating that the error(s) to be corrected arose without any deceptive intention on the part of the applicant.

(c) Having once stated an error upon which the reissue is based, as set forth in paragraph (a)(1), unless all errors previously stated in the oath or declaration are no longer being corrected, a subsequent oath or declaration under paragraph (b) of this section need not specifically identify any other error or errors being corrected.

(d) The oath or declaration required by paragraph (a) of this section may be submitted under the provisions of § 1.53(f).

The reissue oath/declaration is an essential part of a reissue application and must be filed with the application, or within the time period set under 37 CFR 1.53(f) along with the required surcharge as set forth in 37 CFR 1.16(e) in order to avoid abandonment.

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state:

“Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing.”

Alternatively, a declaration can state:

“Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more or less than patentee had the right to claim in the patent.”

Where the specification or drawing is defective and patentee claimed more or less than patentee had the right to claim in the patent, then *both* statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in

CORRECTION OF PATENTS

1414

The question of the sufficiency of the reissue oath/declaration filed under 37 CFR 1.175 must in each case be reviewed and decided personally by the primary examiner.

Reissue oaths or declarations must contain the following:

(A) A statement that the applicant believes the original patent to be wholly or partly inoperative or invalid—

(1) by reason of a defective specification or drawing, or

(2) by reason of the patentee claiming more or less than patentee had the right to claim in the patent;

(B) A statement of at least one error which is relied upon to support the reissue application, *i.e.*, as the basis for the reissue;

(C) A statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant; and

(D) The information required by 37 CFR 1.63.

These elements will now be discussed:

I. A STATEMENT THAT THE APPLICANT BELIEVES THE ORIGINAL PATENT TO BE WHOLLY OR PARTLY INOPERATIVE OR INVALID BY REASON OF A DEFECTIVE SPECIFICATION OR DRAWING, OR BY REASON OF THE PATENTEE CLAIMING MORE OR LESS THAN PATENTEE HAD THE RIGHT TO CLAIM IN THE PATENT.

In order to satisfy this requirement, a declaration can state >as for example<:

"Applicant believes the original patent to be partly inoperative or invalid by reason of a defective specification or drawing."

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"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming more ** than patentee had a right to claim in the patent."

>

"Applicant believes the original patent to be partly inoperative or invalid by reason of the patentee claiming less than patentee had a right to claim in the patent."

<

Where the specification or drawing is defective and patentee claimed >both< more *and< less than patentee had the right to claim in the patent, then *>all three< statements should be included in the reissue oath/declaration. See MPEP § 1412.04 for an exemplary declaration statement when the error being corrected is an error in inventorship.

The above examples will be sufficient to satisfy this requirement without any further statement.

Form paragraph 14.01 may be used where the reissue oath/declaration does not provide the required statement as to applicant's belief that the original patent is wholly or partly inoperative or invalid.

¶ 14.01 Defective Reissue Oath/Declaration, 37 CFR 1.175(a)(1) - No Statement of Defect in the Patent

The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid. See 37 CFR 1.175(a)(1) and see MPEP § 1414. [1]

Examiner Note:

1. Use this form paragraph when applicant: (a) fails to allege that the original patent is inoperative or invalid and/or (b) fails to state the reason of a defective specification or drawing, or of patentee claiming more or less than patentee had the right to claim in the patent. In bracket 1, point out the specific defect to applicant by using the language of (a) and/or (b), as it is appropriate.

2. Form paragraph 14.14 must follow this form paragraph.

II. A STATEMENT OF AT LEAST ONE ERROR WHICH IS RELIED UPON TO SUPPORT THE REISSUE APPLICATION (I.E., THE BASIS FOR THE REISSUE).

(A) A reissue applicant must acknowledge the existence of an error in the specification, drawings, or claims, which error causes the original patent to be defective. *In re Wilder*, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984). A change or departure from the original specification or claims represents an "error" in the original patent under 35 U.S.C. 251. See MPEP § 1402 for a discussion of grounds for filing a reissue that may constitute the "error" required by 35 U.S.C. 251. Not all changes with respect to the patent constitute the "error" required by 35 U.S.C. 251.

(B) Applicant need only specify in the reissue oath/declaration one of the errors upon which reissue is based. Where applicant specifies one such error, this requirement of a reissue oath/declaration is satisfied. Applicant may specify more than one error.



REISSUE APPLICATION DECLARATION BY THE INVENTOR

Docket Number

251496US90RE

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original first and joint inventor (if plural names are listed below) of the subject matter which is described and claimed in the below identified patent:

Patent Number

6,376,049 B1

Date Patent Issued

April 23, 2002

Title of Invention

MULTILAYER PRINTED WIRING BOARD AND ITS MANUFACTURING METHOD, AND RESIN COMPOSITION FOR FILLING THROUGH-HOLE

for which a reissue patent is sought on the invention entitled:

MULTILAYER PRINTED WIRING BOARD AND ITS MANUFACTURING METHOD, AND RESIN COMPOSITION FOR FILLING THROUGH-HOLE

the specification of which

☒ is attached hereto

☐ was filed on _____ as reissue application number _____

☐ and (if applicable) was amended on _____

I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.

We (I) hereby claim foreign priority benefits under 35 USC §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below any foreign application for patent or inventor's certificate, or PCT international application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s):

<u>Application No.</u>	<u>Country</u>	<u>Day/Month/Year</u>	<u>Priority Claimed</u>
9-280499	Japan	14/OCTOBER/1997	YES
9-340180	Japan	10/DECEMBER/1997	YES
9-340182	Japan	10/DECEMBER/1997	YES
10-067065	Japan	17/MARCH/1998	YES

We (I) hereby claim the benefit under 35 USC §119(e) of any United States *provisional* application(s) listed below.

Application Number

Filing Date

We (I) hereby claim the benefit under 35 USC §120 of any United States application(s), or §365I of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 USC §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

Application Serial No.

09/341,689

Filing Date

23/JULY/1999

Status

Patented

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reasons described below. (Check all that apply)

☐ by reason of a defective specification or drawing.

☒ by reason of the patentee claiming more or less than he had the right to claim in the patent.

☐ by reason of other errors.

At least one error upon which reissue is based is described as follows:

Failure to include new Claim 87 substantially corresponding to original patent claim 1, but instead of reciting that the filler comprises metal particles and one of thermosetting and thermoplastic resin, reciting that said at least one via hole is connected to said through-hole-covering conductor layer.

All errors corrected in this reissue application arose without any deceptive intention on the part of the applicant.

COPY

Reissue Application Declaration by the Inventor (Continued)

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected herewith:

Customer Number

22850

Correspondence Address:

OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.

1940 Duke Street

Alexandria, Virginia 22314.

Telephone: (703) 413-3000

Facsimile: (703) 413-2220

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine and imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this declaration is directed.

Full Name of sole or first inventor (given name, family name)

Motoo ASAI

Signature

Motoo Asai

Date

5/19/04

Residence

Gifu, Japan

Citizenship

Japan

Post Office Address c/o IBIDEN CO., LTD., 1-1 Kitagata, Ibigawacho, Ibi-gun, Gifu 501-0601, Japan

Full Name of second joint inventor (given name, family name)

Kenichi-SHIMADA

Signature

Ken-ichi Shimada

Date

5/19/04

Residence

Gifu, Japan

Citizenship

Japan

Post Office Address c/o IBIDEN CO., LTD., 1-1 Kitagata, Ibigawacho, Ibi-gun, Gifu 501-0601, Japan

Full Name of third joint inventor (given name, family name)

Kouta NODA

Signature

Kouta Noda

Date

5/19/04

Residence

Gifu, Japan

Citizenship

Japan

Post Office Address c/o IBIDEN CO., LTD., 1-1 Kitagata, Ibigawacho, Ibi-gun, Gifu 501-0601, Japan

☒ Additional joint inventors are named on separately numbered sheets attached hereto.

Reissue Application Declaration by the Inventor (Continued)

Full Name of forth joint inventor (given name, family name) Takashi KARIYA	
Signature Takashi Kariya	Date 5/19/04
Residence Gifu, JAPAN H:\25s\251496RE\REISSUE_DEC.DOC	Citizenship Japan
Post Office Address c/o IBIDEN CO., LTD., 1-1 Kitagata, Ibigawacho, Ibi-gun, Gifu 501-0601, Japan	
Full Name of fifth joint inventor (given name, family name) Hiroshi SEGAWA	
Signature Hiroshi Segawa	Date 5/21/04
Residence Gifu, Japan	Citizenship Japan
Post Office Address c/o IBIDEN CO., LTD., 1-1 Kitagata, Ibigawacho, Ibi-gun, Gifu 501-0601, Japan	

(OSMMN 03/02)

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